EXHIBIT 8

OIPE
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PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

GOERTZ

Atty. Ref.: 5042-2
(Formerly 3682-32)

Serial No.: 10/315,250

Group: 2174; Conf. No. 1226

Filed: December 10, 2002

Examiner: Pitaro, Ryan F.

For: USER INTERFACE

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August 23, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

Sir:

In response to the Office Action mailed May 24, 2007, please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 9 of this paper.

GOERTZ
Serial No.: 10/315,250

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application.

1. (Currently Amended) A computer readable medium storing a computer program with computer program code, which code, when read by a mobile handheld computer unit, allows the computer to present a user interface for ~~a~~ the mobile handheld computer unit, the user interface comprising:

a touch sensitive area that is simultaneously divided into a menu area and a display area,

the computer unit being adapted to run several applications simultaneously, and to present an active application on top of any other application on the display area, characterised in, that

the menu area ~~being adapted to~~ simultaneously presenting representations of a first function that is a general application dependent function, a second function that is a keyboard function, and a third function that is a task and file manager, and

each of the three functions simultaneously represented in the menu area being activated by the single step of an object moving in a direction from a starting point that is the representation of the function in the menu area to the display area being detected by the touch sensitive area, thereby allowing low precision navigation of the user interface using a blunt object, so that the user interface can be operated by one hand, where the blunt object is a finger.

2. (Currently Amended) The computer readable medium of claim 1, wherein the user interface ~~according to Claim 1,~~ is characterized in, that, if said first function is activated, said

display area is adapted to display icons representing different services or settings depending on the current active application, that one of said icons always represents a "help"-service, regardless of application, and that, if no application is currently active on said computer unit, said icons are adapted to represent services or settings of the operations system of said computer unit.

3. (Currently Amended) The computer readable medium of claim 2, wherein the user interface ~~according to Claim 2,~~ is characterised in, that a selection of a preferred service or setting is done by tapping on corresponding icon.

4. (Currently Amended) The computer readable medium of claim 1, wherein the user interface ~~according to Claim 1,~~ is characterised in,

- that, if said second function is activated, said display area is adapted to display a keyboard and a text field,

- that, if a text passage in said active application is highlighted, said text passage is displayed in said text field for editing through said keyboard and that said highlighted text passage is replaced by said edited text passage when said second function is deactivated, and

- that if no text passage in said active application is highlighted, said text field is available for inputting and editing of text through said keyboard.

5. (Currently Amended) The computer readable medium of claim 4, wherein the user interface ~~according to Claim 4,~~ is characterised in, that if no text passage in said active

application is highlighted, said text field is used for inputting and editing of text through said keyboard, then

- said first function can be activated, or

- said second function can be closed, in which a choice of saving or deleting said inputted text is given, where the choice of saving said inputted text results in an activation of said first function,

in which said first function will present services or settings available for said inputted text.

6. (Currently Amended) The computer readable medium of claim 1, wherein the user interface ~~according to Claim 1,~~ is characterised in, that, if said third function is activated, said display area is adapted to display a list with a library of available applications and files on said computer unit, that a selection of an application will start said application, and that a selection of a file will open said file in an application intended for said file.

7. (Currently Amended) The computer readable medium of claim 6, wherein the user interface ~~according to Claim 6,~~ is characterised in, that a selection of an application or a file is done by moving said object so that the representation of desired application or file is highlighted, removing said object from said touch sensitive area, and then tapping on said touch sensitive area, and that an application or file is highlighted by placing some kind of marking on the representation of said application or file.

8. (Currently Amended) The computer readable medium of claim 7, wherein the user interface ~~according to Claim 7,~~ is characterised in, that said list is adapted to present only said files or only said applications, that the top area of said list presents a field through which the content of said list can be altered, that, if said list only presents files, said field displays a representation of a task manager and a selection of said field will cause said list to alter to present only applications, and that, if said list only presents applications, said field displays a representation of a file manager and a selection of said field will cause said list to alter and present only files.

9. (Currently Amended) The computer readable medium of claim 7, wherein the user interface ~~according to Claim 7,~~ is characterised in, that, a navigation in said list is performed by moving said object in a direction towards the top of said list or towards the bottom of said list, that the movement of said object will cause said marking to move in the same direction, and that the speed of the movement of said marking is lower than the speed of the movement of said object.

10. (Currently Amended) The computer readable medium of claim 9, wherein the user interface ~~according to Claim 9,~~ is characterised in, that, if the number of applications and/or files in said list exceeds the number of applications and files that can be presented on said display area, and if said object is moved to the top or bottom position of said display area, then lifted,

replaced on said display area, and again moved to the top or bottom of said display area, the content of said display area will be replaced one whole page, meaning that if said object is positioned at the bottom of said display area, then lifted, replaced on said display area, and then again moved to the bottom of said display area, the content of said display area will be replaced by the following applications and/or files in said list, and if said object is positioned at the top of said display area, then lifted, replaced on said display area, and then again moved to the top of said display area, the content of said display area will be replaced by the preceding applications and/or files in said list.

11. (Currently Amended) The computer readable medium of claim 10, wherein the user interface ~~according to Claim 10,~~ is characterised in, that if said object is removed from any first position on said display area and then replaced on any second position on said display area, said navigation can be continued from said second position.

12. (Currently Amended) The computer readable medium of claim 1, wherein the user interface ~~according to Claim 1,~~ is characterised in, that an active application, function, service or setting is moved on one step by moving said object from the left of said display area to the right of said display area, and that the active application, function, service or setting is closed or backed one step by moving said object from the right of said display area to the left of said display area.

13. (Currently Amended) The computer readable medium of claim 1, wherein the user interface ~~according to Claim 1,~~ is characterised in, that said menu area is positioned at the bottom of said touch sensitive area, that said representation of said first function is positioned at the left side of said menu area, that said representation of said second function is positioned at the middle of said menu area, and that said representation of said third function is positioned at the right side of said menu area.

14. (Currently Amended) The computer readable medium of claim 1, wherein the user interface ~~according to Claim 1,~~ is characterised in, that said user interface is adapted to a touch sensitive area with a size that is in the order of 2-3 inches, and that said user interface is adapted to be operated by one hand, where said object can be a finger.

15. (Currently Amended) An enclosure adapted to cover a computer unit, said computer unit being adapted to read computer program code of a computer program stored on a computer readable medium, which code, when read, presents a user interface according to Claim 1, characterised in, that said enclosure is provided with an opening for said display area, and that a representation of said menu area is printed on top of said enclosure.

16. (Previously Presented) The enclosure according to Claim 15, characterised in, that said enclosure is removable and exchangeable.

17. (Original) A computer readable medium, with a computer program product stored therein, characterised in, that said computer program product comprises computer readable code, which, when read by a computer, will make it possible for said computer to present a user interface according to Claim 1.

18. (Original) A computer readable medium according to Claim 17, characterised in, that said computer program product is adapted to function as a shell upon an operations system.

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-18 are pending in the application. Upon entry of this amendment, claims 1-15 will be amended.

In the outstanding Office Action of May 24, 2007, the Examiner rejected claims 1-16, under 35 U.S.C. §101, as being directed to non-statutory subject matter, arguing that the claimed user interface "is simply nonfunctional descriptive material *per se*, and therefore lacks actual data structure to be considered statutory." 5/24/07 Office Action, p. 2. The Examiner's rejection is respectfully traversed.

Annex IV, titled "Computer-Related Non-Statutory Subject Matter", of the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility", published in the November 22, 2005 Official Gazette of the United States Patent and Trademark Office defines both "functional descriptive material" and "non-functional descriptive material". "Functional descriptive material" is defined by Annex IV as material consisting of data structures and computer programs which impart functionality when employed as a computer component. A "data structure" is defined by Annex IV as a physical or logical relationship among data elements, designed to support specific data manipulation functions, quoting The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993). In contrast, "non-functional descriptive material" is defined by Annex IV as including, but not being limited to, music, literary works and a compilation or mere arrangement of data. A copy of Annex IV from

the November 22, 2005 OG Notice is submitted with this Amendment as Attachment A to this Amendment.

Claim 1 of the present application, the only independent claim in the present application, has now been amended to recite a computer readable medium storing a computer program with computer program code, which code, when read by a mobile handheld computer unit, makes it possible for the computer to present a user interface for the computer that is described in claim 1 of the present application. The user interface, which is divided into a menu area and a display area, simultaneously presents, in the menu area, a first function that is a general application dependent function, a second function that is a keyboard function, and a third function that is a task and file manager. The touch sensitive user interface allows these functions to be activated by a single step of an object moving in a direction from a starting point that is a representation of the function in the menu area to the display area, thereby allowing a user to use the computer with a single hand and activate the recited functions with a blunt object, such as a finger. Clearly, in its amended form, claim 1 recites functional material. Claims 2-14 have been amended to conform them to amended claim 1. In addition, claim 15 has been amended to recite that the computer unit recited in the claim is adapted to read computer program code of a computer program stored on a computer-readable medium, which code, when read, presents the user interface of claim 1. As such, applicant believes that claims 1-16 now recite statutory subject matter, and that the Examiner's rejection of claims 1-16 under §101 should now be withdrawn. Support for the foregoing amendments to claims 1-15 appear at least at page 1, lines 12-15 of the specification of the present application.

In the outstanding Office Action, the Examiner also rejected , as being unpatentable under 35 U.S.C. §103(a), claims 1, 4-7, 12, 15 and 17 over Carlson ("Carlson", Carlson, Jeff. Visual Quickstart Guide Palm Organizers, Peachpit Press. 2000. Berkely, CA.) in view of Haitini *et al.* (USP 5,900,875) and further in view of Venolia *et al.* ("Venolia", T-Cube: A Fast, Self-Disclosing Pen-Based Alphabet), claims 2 and 3 over Carlson, Haitini *et al.* and Venolia *et al.* in view of Kopitzke *et al.* (USP 6,988,246 B2), claim 8-11 over Carlson in view of Haitini *et al.* in view of Venolia, in view of Wynn *et al.* (USP 6,734,833 B1), claim 13 over Carlson in view of Haitini in view of Venolia, claims 14 and 16 over Carlson, Haitini *et al.* and Venolia in view of Strietelmeier ("Strietelmeier, Julia "Palm m100. The Gadgeteer. 2000. http://www.the-gadgeteer.com/review/palm_m100_review>), and claim 18 over Carlson in view of Chew *et al.* (USP 6,727,917), Haitani *et al.* and Venolia *et al.* The Examiner's rejections are respectfully traversed.

Assuming, *arguendo*, that the Examiner properly combined the cited references, the resulting combination would still not be the claimed invention because such references do not disclose or suggest all of the limitations of the claimed invention. Specifically, claim 1 of the present application, the only independent claim pending in the application and the one claim from which claims 2 – 18 depend, either directly or indirectly, recites a user interface for a hand held computer unit that includes a touch sensitive area simultaneously divided into a menu area and a display area, with the menu area simultaneously presenting a first function that is a general application dependent function, a second function that is a keyboard function, and a third function that is a task and file manager. Claim 1 also recites that each of the three functions

simultaneously presented in the menu area are activated by the single step of an object moving in a direction from a starting point that is the representation of the function in the menu area to the display area being detected by the touch sensitive area, thereby allowing low precision navigation of the user interface using a blunt object, so that the user interface can be operated by one hand, where the blunt object is a finger. One embodiment of the three functions recited in claim 1 is described in the specification of the present application in reference to Figures 3, 5 and 6, respectively, of the present application.

The three functions simultaneously represented in the menu area and activated by a touch sensitive area detecting the single step of an object moving in a direction from a starting point that is the representation of the function in the menu area to a display area, as recited in independent claim 1, are not described in the primary Carlson reference, the secondary Haitani reference or the tertiary Venolia reference cited by the Examiner in the claim rejections set forth in the outstanding Office Action. Given these deficiencies in the cited references, discussed below, it must be concluded that claims 1 – 18 of the present application are not obvious over the cited references.

In the outstanding Office Action, the Examiner recognized that Carlson fails to disclose the first, second and third functions recited in independent claim 1 of the present application, 5/24/07 Office Action, p. 4, as argued by applicant in the Amendment After Final Rejection previously filed on March 15, 2007. In an effort to overcome this deficiency in the teaching of Carlson, the Examiner points to the Haitani patent as disclosing a "menu area being adapted to simultaneously present representations of a first function that is a general application-dependent

function (Figure 1, items 151, 153), a second function that is a keyboard function (Figure 1, item 145) and a third function that is a task and file manager (Figure 1, item 141)." 5/24/07 Office Action, p. 4. A review of Haitani reveals, however, that this patent does not disclose the first, second and third functions recited in independent claim 1, as argued by the Examiner.

Haitani discloses a portable computer system 100 that is shown in Figure 1 of Haitani. The computer system 100 shown in Figure 1 includes a screen display area 181 that is used to display information to a user. Haitani, col. 2, lns. 40 – 42. Below the display area 181 is a user input area 183. Haitani, col. 2, ln. 45. The user input area 183 is used to input text in the Graffiti® writing area 145 and interact with the application buttons 141 through 144. Haitani, col. 2, lns. 45 – 48. Both the screen display area and the user input area 183 are covered by a digitizer pad that can detect user interaction with a stylus or finger. Haitani, col. 2, lns. 42 – 44 and 48 – 49. Below the area 183 is a mechanical button input area 185 that includes seven different mechanical buttons 121, 123, 125, 127, 129 and 131. Haitani, col. 2, lns. 50-53. Thus, it should first be noted that items 141, 145 and 151 and 153 are not all located in the same menu area, as are the representations of the three functions recited in claim 1 of the present application.

Haitani describes the seven mechanical buttons as including "[a] pair of scrolling buttons 131 that are used to scroll information in the display area 181 up and down." Haitani, col. 2, lns. 64 – 65. Haitani also states that "[t]he scrolling buttons 141 [sic] allow a user to view a list of information that does not fit on the display." Haitani, col. 2, lns. 65 – 67. This last statement appears to conflict with the earlier description of item 141 as being one of the application buttons 141 through 144 located in Graffiti® writing area 145. Indeed, item 141 is not shown in Figure 1

as a pair of buttons, but, rather, a single icon including an arrow symbol in a circle and the word "applications" underneath the arrow symbol and circle. *See* Haitani, Figure 1.

There is no description in Haitani of the items 151 and 153 shown in the screen display area 181 of Figure 1 of Haitani and cited by the Examiner as being "a general application-dependent function (Figure 1, items 151, 153)". 5/24/07 Office Action, p. 4. Thus, it is not clear how the Examiner has concluded that items 151 and 153 in Figure 1 represent the first function that is a general application-dependent function recited in claim 1 of the present application, particularly when Haitani does not even discuss items 151 and 153.

In addition, the "Graffiti® writing area" 145 shown in Figure 1 of Haitani is not the second, keyboard function recited in claim 1 of the present application. The Graffiti® writing area 145 is clearly not a keyboard, but rather an input area that is used to input written characters. *See, e.g.,* Attachment B to this Amendment.

Finally, as discussed above, item 141 is not the third, task and file manager function recited in claim 1, since it is described by Haitani as being part of the application buttons and shown in Figure 1 of Haitani as an icon including an arrow symbol in a circle and the word "applications" underneath the arrow symbol and circle.

Putting aside claim 1's recitation that each of the three functions simultaneously presented in the menu area are activated by the single step of an object moving in a direction from a starting point that is the representation of the function in the menu area to the display area so as to be detected by the touch sensitive area, it is clear from the foregoing discussion of

Carlson and Haitani these a combination of these two references would not result in the invention described in independent claim 1 of the present application.

In the outstanding Office Action, the Examiner also recognized that Carlson, even as modified by Haitani, still does not disclose the single step function activation feature recited in claim 1. 5/24/07 Office Action, pp. 4 and 5. To compensate for this deficiency, the Examiner next argues that "Venolia teaches activating by the single step of an object moving in a direction from a starting point that is representation [sic] of the function in the menu area to the display area (Column 2, flick gestures)", described in column 2 of Venolia. It should be noted here that claim 1 of the present application recites not just a step of an object moving in a given direction for activation, but, rather, that each of the three functions recited in claim 1 are activated by the single step of an object moving in a direction from a starting point that is the representation of the function in the menu area to the display area, which is detected by touching the sensitive area, thereby allowing low precision navigation of a user interface using a blunt object, such as a finger, so that the user interface can be operated by one hand.

Contrary to the Examiner's assertion, Venolia does not disclose activating various functions in a computer by the single step of moving an object in a direction from a starting point that is a representation of a selected function in a menu area to a display area, as recited in independent claim 1 of the present application. Rather, Venolia discloses a technique for entering text to a pen-based computer based on a "new alphabet" where each letter in the alphabet is a entered using a flick gesture. The flick gestures are self-disclosing using prime

menus. There is an assignment of characters to the gestures used with the pen-based computer disclosed in Venolia.

The method of entering text using a pen and flick gestures described in Venolia is identified as "T-Cube". Venolia does describe as part of T-Cube the use of a flick gesture with a starting point and a direction. The user presses the pen in one of nine target cells so that a pie menu appears offset from the pen. The direction of the flick of the pen can be vertical, horizontal or directional, specifying one of eight directions. A combination of these eight directions and nine starting cells in a pie menu yields 72 different gestures, with each gesture representing a character, such as "w" or "7", or an operation, such as a backspace, return or shift. Thus, the pen movements described in Venolia are not intended to activate a function, but, rather, to enter characters in a small computer. The flick gestures described in Venolia do not describe a single step of an object moving in a direction from a starting point that is the representation of one of several functions in a menu area to a display area to activate a selected function, as recited in independent claim 1 of the present application. Thus, it is clear that the combination of Carlson, Haitani and Venolia does not result in the invention described in independent claim 1 of the present application.

The other additional references cited by the Examiner do not compensate for the deficiencies in the Carlson, Haitani and Venolia references discussed above.

Kopitzke *et al.* discloses a monitoring and control device includes a touch sensitive LCD screen, with a basic layout including a display area and touch sensitive keys depicted with associated system and function symbols. A main menu or any one of plural system menus can be

selectively displayed in the display area. The system menus relate to cabin systems such as audio, lighting, and water systems. The selected system menu displays status information and touch input keys for the user to monitor the status and to select and control the operation of the system. The main menu is a top level window providing essential information regarding all of the cabin systems and allows a user to select any one of the system menus.

Wynn *et al.* discloses a graphical user interface control for entering a user selection from a list of possible selections in which the user can "spin" through a list of items shown on preview and postview option lists. The control allows the user to spin forwards and backwards, with a preview list of items and a postview list of items being displayed on opposing sides of the currently selected item dialog box. By providing visibility to the upcoming and recently past selections during the spin, a user can operate the spin control at a higher speed, thereby reducing the amount of time necessary to find the desired item on the list.

Chew *et al.* discloses a hand-held computing device user interface that displays information for an active application program in a middle portion of the screen, and displays a shell program controlled navigation bar at a top portion of the screen. The navigation bar includes a navigation icon which, when tapped by the stylus, aids the user in navigating to other application programs. The navigation bar also includes a title for the active application program to save vertical real estate on the screen. The user interface also displays an application menu bar at a bottom portion of the screen so that the user can manipulate data from the active application by tapping menu items with a stylus without blocking view of the middle portion of the display.

The Gadgeteer article by Strietelmeier is a review of the Palm m100. The article talks about the Palm m100 having a cheaper feel than the prior Palm IIIc. It also talks about new features on the m100, such as an integrated flip cover, a small window that allows viewing of time and date when the up hardware scroll button is pressed, the removability of the flip cover for use of different color face plates, large and separate up/down scroll buttons, a smaller plastic LCD display, an IR port for beaming files back and forth to other Palm devices, a battery door, reset switch, stylus silo and hot sync port on the back of the unit, a louder internal speaker, limited RAM of 2MB, use of AAA batteries to power the device, and changes to the m100 software, such as the addition of a notepad application and a clock application and the removal of mail or expense applications.

Thus, it is clear that independent claim 1 of the present application is not obvious over the references of record cited by the Examiner in the outstanding Office Action of May 24, 2007. And, because independent claim 1 is not obvious over such references, dependent claims 2-18, which depend either directly or indirectly from claim 1, are also not obvious over such references.

In view of the foregoing, it is believed that all of the claims pending in the application, *i.e.*, claims 1 – 18, are now in condition for allowance, which action is earnestly solicited. If any

issues remain in this application, the Examiner is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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